

**REMARKS**

Claims 32-46, and 52-59 are currently pending. Claims 47-51 are cancelled herein.

**35 U.S.C. §112**

The Office Action rejected claims 32-47 under 35 U.S.C. §112, 1<sup>st</sup> paragraph stating that the specification does not provide enablement for closing an opening or merely heating the disc while the electrode is in contact with, or in close proximity to, the outer surface of the disc. In response to previous arguments presented by the applicant, the Office Action asserted that the disclosure at page 5 fails to specifically set forth the invention as claimed since no details are set forth relating to the opening or mere heating.

Again, applicant disagrees. Defects associated with vertebral discs are commonly known by those skilled in the art. For example, on page 5 lines 29-32, the specification clearly provides “[i]n other embodiments, the present invention may be used to both ablate the extruded portion of the nucleus pulposus, and then to contract or shrink the inner disc material to allow repair of the annulus.” In this instance, one skilled in the art will readily understand that a defective annulus with an extruded portion of nucleus pulposus may have a variety of pathologies, one of which includes an opening in the annulus. Furthermore, as previously argued, applicant’s specification clearly mentions treatment of openings in the annulus, such as those associated with the introduction of devices into an annulus.

Applicant further cites to page 33, line 17 through page 34 line 15. In these sections, the specification teaches that “the electrode terminal(s) 104 are held away from the tissue a sufficient distance such that the RF current does not pass into the tissue at all, but rather passes through the electrically conducting fluid back to the return electrode” and that “[i]n an alternative embodiment, the electrode terminal(s) 104 are brought into contact with, or close proximity to, the target tissue so that the electric current passes directly into the tissue to a selected depth.” Clearly, the specification teaches heating the disc while the electrode is in contact with, or in close proximity to, the outer surface of the disc.

In view of the above, applicant respectfully requests withdrawal of this rejection.

35 U.S.C. §102

The Office Action rejected claims 47, 48, 50, and 51 as being anticipated by either Lax et al. (5,458,596) or Baker (5,514,130). Applicant disagrees.

However, to expedite prosecution of this application, applicant has cancelled claims 47-51. Applicant reserves the right to pursue these claims in any continuing application.

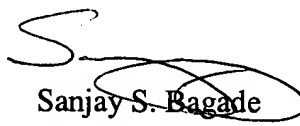
Provisional Double Patenting

The Office Action rejected claims 52-59 under judicial double patenting. Applicant disagrees. In any event, to expedite prosecution of the application, applicant submits a terminal disclaimer herewith.

SUMMARY

Applicant believes all outstanding issue raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,

  
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